

1 The opinion in support of the decision being entered today was *not* written  
2 for publication and is *not* binding precedent of the Board

3  
4 UNITED STATES PATENT AND TRADEMARK OFFICE

5  
6  
7 BEFORE THE BOARD OF PATENT APPEALS  
8 AND INTERFERENCES  
9

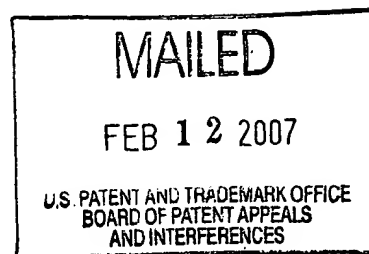
10  
11 *Ex parte* KI-OOK PARK, IN-EUNG KIM  
12 IN-SEOP JEONG and TAE-SEOK PARK  
13

14  
15 Appeal 2007-0112  
16 Reissue Application 09/892,790<sup>1</sup>  
17 Patent 5,917,679  
18 Technology Center 2600  
19

20  
21 Oral Argument: None<sup>2</sup>  
22 Decided: February 12, 2007  
23

24  
25 *Before:* FRED E. McKELVEY, *Senior Administrative Patent Judge*, and  
26 HOWARD B. BLANKENSHIP and ALLEN R. MacDONALD,  
27 *Administrative Patent Judges.*

28  
29 McKELVEY, *Senior Administrative Patent Judge.*  
30



<sup>1</sup> Reissue application filed 28 June 2001 seeking to reissue U.S. Patent 5,917,679, granted 29 June 1999, based on application 08/915,342 filed 22 August 1997. The real party in interest is Samsung Electronics Co., Ltd.

<sup>2</sup> Oral argument was scheduled for 21 February 2007. In preparing for oral argument, it became apparent that further action by the Examiner was required. Accordingly, oral argument was cancelled, counsel for Appellants being notified by phone 6 February 2007 of the cancellation.

**MEMORANDUM OPINION and ORDER**  
**Limited Remand**

**A. Statement of the case**

The appeal is from a decision of the Examiner rejecting claims 21, 30-32 and 41 under 35 U.S.C. § 102 as being “clearly anticipated” by Nepela, U.S. Patent 5,568,981, issued 29 October 1996 based on an application filed 10 April 1995.

Nepela is prior art under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e).

In the answer, the Examiner states (page 4):

Note figure 5c. NEPELA et al shows a negative pressure slider with a U-shaped air bearing platform (108) defining a negative pressure cavity (not numbered—the area between the two rear extending legs of the U), the U-shaped air bearing platform having a cross rail portion (not numbered) and not more than two separate air bearing platforms (not numbered—the rear extending legs) which terminate before the rear edge of the slider, the not more than two separate air bearing platforms have side wall portions (not numbered), and a centered rear air bearing platform (120) which mounts a transducer.

**B. Discussion**

We start out with the observation that it is not readily apparent to us how claims 21, 30-32 and 41 are “clearly anticipated” by Nepela. Nor are we sure if there is a difference is between “clearly anticipated” and “anticipated.”

The Examiner, however, believes the claims on appeal are anticipated. The Examiner no doubt is considerably more knowledgeable about the art than we are. Furthermore, because of that knowledge, the Examiner may have been inclined to make justified assumptions about the scope and content of Nepela which we are unable to appreciate.

We would appreciate further input from the Examiner on precisely how the Examiner sees the claims on appeal to be anticipated. Most respectfully, we ask the Examiner to reproduce each of the claims on appeal and after each claim limitation insert a reference to the drawing element and specification (by column and lines) so that we can better appreciate how the Examiner believes that all the limitations of the claims are described by Nepela.

We call the Examiner's attention to *Ex parte Braeken*, 54 USPQ2d 1110 (Bd. Pat. App. & Int. 1999), for a suggested format to be followed.

With respect to claim 21 on appeal, the Examiner may use the following format:

21. A negative pressure air bearing slider (col. \_\_, line \_\_; Fig. \_\_, element \_\_) having a negative pressure cavity (col. \_\_, line \_\_; Fig. \_\_, element \_\_), comprising:

a body with a principal surface (col. \_\_, line \_\_; Fig. \_\_, element \_\_) disposed to confront a recording surface (col. \_\_, line \_\_; Fig. \_\_, element \_\_) of a recording medium (col. \_\_, line \_\_; Fig. \_\_, element \_\_), said principal surface having a lead portion (col. \_\_, line \_\_; Fig. \_\_, element \_\_) and a rear portion (col. \_\_, line \_\_; Fig. \_\_, element \_\_), said lead portion being spaced upstream from said rear portion relative to a rotational direction (col. \_\_, line \_\_; Fig. \_\_, element \_\_) of any recording medium confronted by said slider, said lead portion having a front edge (col. \_\_, line \_\_; Fig. \_\_, element \_\_), said rear portion having a rear edge (col. \_\_, line \_\_; Fig. \_\_, element \_\_), said front edge and said rear edge together defining boundaries (col. \_\_, line \_\_; Fig. \_\_, element \_\_) of said principal surface in a longitudinal direction (col. \_\_, line \_\_; Fig. \_\_, element \_\_) of said slider body; and

1 a U-shaped air bearing platform (col. \_\_, line \_\_; Fig. \_\_,  
2 element \_\_) defining a negative pressure cavity (col. \_\_, line \_\_;  
3 Fig. \_\_, element \_\_) on said principal surface (col. \_\_, line \_\_;  
4 Fig. \_\_, element \_\_), said U-shaped air bearing platform  
5 comprising not more than two separate air bearing platforms  
6 (col. \_\_, line \_\_; Fig. \_\_, element \_\_) each extending rearwardly  
7 (col. \_\_, line \_\_; Fig. \_\_, element \_\_) toward said rear portion of  
8 said principal surface and respectively terminating (col. \_\_, line  
9 \_\_; Fig. \_\_, element \_\_) at a first rear termination (col. \_\_, line \_\_;  
10 Fig. \_\_, element \_\_) and a second rear termination (col. \_\_, line  
11 \_\_; Fig. \_\_, element \_\_), at least one of said not more than two  
12 separate air bearing platforms including a side wall portion (col.  
13 \_\_, line \_\_; Fig. \_\_, element \_\_);

14  
15 at least one of said first rear termination and said second  
16 rear termination not coinciding (col. \_\_, line \_\_; Fig. \_\_, element  
17 \_\_) with said rear edge, and being disposed upstream (col. \_\_,  
18 line \_\_; Fig. \_\_, element \_\_) of said rear edge relative to said  
19 rotational direction (col. \_\_, line \_\_; Fig. \_\_, element \_\_) of said  
20 recording medium.  
21

22 The Examiner may use a similar format for the other four claims on  
23 appeal. Based on the Examiner's discussion in the answer, it may be that  
24 certain elements of the claims on appeal are not numbered in the drawings.  
25 The Examiner should feel free to reproduce a copy of any relevant figure of  
26 the drawings and add numbers to elements not otherwise numbered and  
27 include a copy of the drawing with the response to this remand.

28 We appreciate the fact that this remand is the second remand to the  
29 Examiner, the first having to do with a recapture rejection which the  
30 Examiner has withdrawn. However, where possible, a proper decision on  
31 the merits is to be achieved and we are confident we will be able to better

1 appreciate how Nepela is believed to anticipate the claims after we receive  
2 what we expect will be valuable input from the Examiner.

3  
4 **C. Order**

5 Upon consideration of the record on appeal, and for the reasons given,  
6 it is

7 ORDERED that the appeal is remanded to the Examiner for  
8 action not inconsistent with views expressed in this opinion.

9 FURTHER ORDERED that except as otherwise expressly  
10 provided herein, the Board retains jurisdiction over the appeal.

11 FURTHER ORDERED that within **one (1) month** of the date  
12 the Examiner enters a response to this remand, Appellants may file a paper  
13 (not to exceed 10 pages) addressing the Examiner's response.

14 FURTHER ORDERED that oral argument scheduled for  
15 21 February 2007 is cancelled and will be reset in due course.

16 FURTHER ORDERED that, unless otherwise ordered, the  
17 provisions of 37 C.F.R. § 1.136(a) (2006) are not applicable to further  
18 proceedings involving the application on appeal.

19  
20 McK/lp

21  
22 cc (via First Class Mail):

23  
24 Robert E. Bushnell, Esq.  
25 1522 "K" Street, N.W., Suite 300  
26 Washington, D.C. 20005

27  
28 Tel: 202-408-9040